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EXAMINER

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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DETAILED ACTION

I. ACTION SUMMARY

Claims 1-12 are currently pending in the instant application.

II. PRIORITY

This application is a 371 of PCT/EP03/50932, filed on December 3, 2003 and claims priority under 35 U.S.C. § 119(a-d) to foreign application ITALY MI2002A002658, filed December 17, 2002.

III. RESTRICTION-LACK OF UNITY OF INVENTION

Restriction is required under 35 U.S.C. 121 and 372 because the instant application contains the following inventions or groups of inventions which are not so linked to form a single general inventive concept under PCT Rule 13.1. Therefore a restriction is required according to the provision of PCT Rule 13.2.

The instant application contains Markush practice. However, pursuant to Section B (Markush Practice) MPEP § 1850 (B), the invention does not meet the unity of invention criteria because (1) the core structure is not the unifying criteria and (2) the variables do not belong to a "recognized class of chemical compounds in the art to which the invention pertains." MPEP § 1850 (B) (2004).

Formula (I), R-NR1c(K)k0-(B)b0-(C)b0-NO2, as recited in Claim 1 is the genus. The special technical feature is the NO2 as all the other variables have different meanings. Unity of invention is lacking because there is no core and the special technical feature is not novel. Thus, Claims 1-12 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.2 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention). PCT Rule 13.2 states unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

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Annex B, Part 1 (b), provides that “special technical features” mean those technical features, which, as a whole, define a contribution over the prior art.

Annex B, Part 1 (e), provides combinations of different categories of claims and states:

“The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claims for a process specially adapted for the manufacture of the said product, and an independent claim for use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specially designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, and independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specially designed for carrying out the said process,...

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous and widely-divergent variables in the compound of Formula (I), such as **R**, **R1c**, **K**, **B**, etc. a precise listing of inventive groups cannot be made. Alternatively, the Examiner requests a specie election for search purposes.

Group I Claims 1-10, drawn to the compounds of Formula (I). Election of a specie of formula (I) is further required.

Group II Claims 11 and 12, drawn to the methods of using the compound of Formula (I). Election of a specie of formula (I) is further required.

Markush Claims

A provisional election of a species is required because the Markush-type claims of the instant application include distinct independent inventions. Restriction of a Markush group is proper where the compounds within the group either (1) do not share a common utility, or (2) do not share a substantial structural feature disclosed as being essential to that utility. See In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); See also Ex Parte Hozumi, 3 USPQ2d 1059 (BPAI 1984). Absent evidence that subject matter of the Markush-type claim lacks unity of invention, the Office may not merely "refuse to examine that which applicants regard as their invention." See M.P.E.P. § 803.02; In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility. Additionally, a Markush group may encompass a plurality of independent and distinct inventions where two or more members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the other member(s) obvious under 35 U.S.C. §103. **Therefore, in addition to an election of one of the abovementioned Inventions, restriction is further required under 35 U.S.C. § 121.**

Upon election of an invention, election of a single species is further required, including an exact definition of each substitution on the base molecule, (i.e., Formula (I)), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R3 and X, wherein R3 is recited to be any one of hydrogen, aryl, arylalkyl, or arylalkenyl, and X is O or S, etc., then applicant must select a single substituent for R3 or X. For instance: R3 is methyl and X is O. This process is repeated for each variable so that a single compound is identified.

In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound. The elected compounds should be similar that they will encompass the same inventive concept and reduction to practice. The scope of an independent invention will encompass all compounds within the scope of the claim, which fall into the same class and subclass as the elected compound, but may also include additional compounds, which fall in

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related subclasses. Examination will then proceed on the elected compound and the entire scope of the invention encompassing the elected compound as defined by common classification.

A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with (if appropriate) the process of using or making said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined. Should applicant traverse on the ground that the compound are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compound to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.

Applicant is reminded that upon cancellation of claims to a nonelected invention, the inventions must be amended in compliance with 37 C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

Applicants can review the claims and disclosure to determine the scope of the invention and can set forth a group of compounds, which are so similar, within the same inventive concept and reduction to practice. Markush claims require sufficient support in the disclosure for each member of the Markush group. See MPEP § 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the core structure as the selected species must be consistent with the written description.

Advisory of Rejoinder

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01. Applicant is reminded that upon cancellation of claims to a nonelected invention, the inventions must be amended in compliance with 37 C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. As stated above, this is not an exhaustive list, as it would be impossible to produce such a list under the time constraints due to the large volume of subject matter claimed in this application.

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The claims herein lack unity of invention under PCT Rules 13.1 and 13.2 because, pursuant to 37 C.F.R. 1.475(a) the instant invention lacks unity of invention since under 37 CFR 1.475:

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical feature among those inventions involving one or more of the same or corresponding special technical features...those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The structural moiety common to **Groups I and II** is the -NO_2 moiety, and is therefore the *technical feature*. However, this technical feature is not a *special technical feature*, because it fails to define a contribution over the prior art (*See*, Del Soldato, et al., WO 02/11707A2 for example). Therefore, Claims 1-12 are not so linked as to form a single general inventive concept and there is a lack of unity of invention. The variables vary extensively and when taken as a whole result in vastly different compounds. Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter impose a serious burden on any examination of the claimed subject matter.

Because the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical features, the claims lack unity of invention and should be limited to a product, a process for the manufacture of said product, or a method of use.

Furthermore, with respect to **Groups I and II**, even if unity of invention under 37 CFR 1.475(a) is not lacking, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

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- (4) A process and an apparatus or means specially designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specially designed for carrying out the said process.

Moreover, according to 37 CFR 1.475(c),

If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

In the instant case the claims are drawn to more than one product, process, and method of use. According to 37 CFR 1.475(e),

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

As a result, the claims lack unity of invention and applicant is required to elect a single invention and a single compound, including an exact definition of all substituents and variables wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R₁, wherein R₁ is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc., then applicant must select a single substituent of R₁, for example OH or aryl and each subsequent variable position.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even if the restriction requirement is traversed (37 CFR 1.143).

Telephonic Inquiry

A telephone call was made to Amy Schoenhard, Esquire on or about February 9, 2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

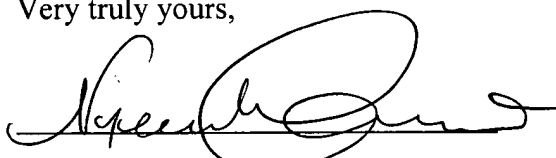
IV. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Friday from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

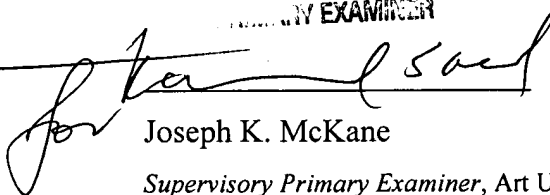
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Very truly yours,


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